

## REMARKS

The Final Rejection dated June 14, 2006, has been carefully considered. In response thereto, the present application is believed to place it into condition for allowance. Accordingly, reconsideration and withdrawal of the outstanding Office Action and issuance of a Notice of Allowance are respectfully solicited.

Before traversing the outstanding grounds of rejection, the Applicant will address the "Response to Arguments" set forth on pages 2-4 of the Final Rejection.

Part A notes that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." However, the Applicant has made no such argument. Instead, the Applicant has explained how the present claimed invention would not have been obvious over *the combination* of references proposed in the previous Office Action.

Part A goes on to assert that the proposed combination "is obvious to protect the privacy and integrity of information stored on each user's device." However, what is obvious now is beside the point. What matters is what would have been obvious to "the skilled artisan .. *with no knowledge of the claimed invention....*" *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). The Office has the burden of explaining why such an artisan would have selected the elements from the applied references. *Id.* There is no such showing in the Final Rejection.

Part B alleges that the Applicant's arguments regarding teachings of the prior art that teach away from the combination "are unrelated to the claimed invention and irrelevant to the use of the references as prior art in the rejection of the above claims." That argument is incorrect as a matter of law. It is well settled law that the Office is not at liberty to pick and choose which teachings it will apply from each reference. Instead, it is legally bound to consider "disclosures

in the references that diverge from and teach away from the invention at hand.” *W. L. Gore & Associates, Inc., v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983).

The Applicant respectfully traverses the rejection of claims 1-4 and 7 under 35 U.S.C. § 103(a) over *Schneider et al* in view of *Weschler*. The mere fact that the prior art could have been modified in a certain way does not suffice to show that the modification would have been obvious. *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). Instead, the prior art must suggest the desirability of the modification. *Id.* That desirability must be shown "from positive, concrete evidence of record which justifies a combination of primary and secondary references." *Id.* Moreover,

the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

*In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). The permissible sources for motivation are "the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *Id.*

*Schneider et al* uses an access control database in which changes are propagated to all local copies. *Weschler* teaches an improvement on LDAP queries. There would have been no reason to incorporate the LDAP queries of *Weschler* into the access control database of *Schneider et al*, since the local copies would already have the updated information. Accordingly, the Applicant respectfully submits that the proposed combination of references would have been pointless and therefore non-obvious, and the prior art of record does not suggest the desirability of the modification.

The Applicant further traverses the rejection of claims 28-36, 38-44, 47 and 51 under 35 U.S.C. § 103(a) over *Kleinpeter III* in view of *Schneider et al*. Similarly to the arguments set

forth above, the updating of the local copies in *Schneider et al* would have obviated the need for the agent server of *Kleinpeter III et al*. Accordingly, the Applicant respectfully submits that the combination of *Schneider et al* with *Kleinpeter III et al* would have been equally non-obvious.

Finally, the Applicant respectfully traverses the rejection of claims 5, 6, 37, 45 and 46 under 35 U.S.C. § 103(a) over *Schneider et al* in view of *Weschler* and further in view of *Kleinpeter III et al*. The combination of the three references suffers from the same deficiencies as both of the combinations of two references discussed above.


As all grounds of rejection have been addressed and overcome, the Applicants respectfully submit that the application is in condition for allowance. Notice of such allowance is respectfully solicited.

In the event there are any questions relating to this Response or to the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Please charge any shortage of fees or credit any overpayment thereof to BLANK ROME LLP, Deposit Account No. 23-2185 (114944-00208). In the event that a separate Petition for an Extension of Time is required to render this submission timely and either does not accompany this Response or is insufficient to render this Response timely, the Applicant herewith petitions under 37 C.F.R. §1.136(a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized above.

Respectfully submitted,

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